

### **REMARKS**

In response to the Office Action of August 24, 2008, Applicant respectfully requests reconsideration. To further the prosecution of this application, each of the rejections set forth in the Office Action has been carefully considered and is addressed below. The application as presented is believed to be in condition for allowance.

#### **Objection to the Drawings**

The Office Action objects to Figure 1, asserting that it uses different reference numbers for the same element. Applicant respectfully disagrees with this rejection. Figure 1 depicts a plurality of host computers. Indeed, as stated in Applicant's specification, at page 5, lines 2-3, "Figure 1 shows a storage system 101 that communicates with a plurality of hosts 105a, 105b, ..., 105n through a network 103. Thus, the reference numbers 105a, 105b, ..., 105n do not refer to the same element. Rather, each Host in Figure 1 is a separate computer and is therefore labeled with a different reference number. As such, Figure 1 is believed to satisfy all requirements of 37 C.F.R. §1.84, and it is respectfully requested that the objection to Figure 1 be withdrawn.

The Office Action objects to Figure 2, asserting that there is a spelling error in item 205. Applicant respectfully disagrees. Element 205 in Figure 2 is labeled "Content Address," and is spelled correctly. Accordingly, it is respectfully requested that this objection be withdrawn.

The Office Action objects to Figure 3 stating, "lines associated with reference numbers and elements appear combined." Applicant believes the lines in Figure 3 are clear. Nevertheless, Applicant submits herewith a replacement Figure 3 to make the lines shown therein even more clear.

#### **Rejections Under 35 U.S.C. §112**

##### *Claims 70-74*

The Office Action rejects claims 70-74 under 35 U.S.C. §112, second paragraph asserting that claim 70 covers more than one statutory class. Applicant respectfully traverses this rejection.

The Office Action contends that claim 70 is directed to more than one statutory class because it recites "at least one computer readable medium" and "a method." In support of this

reasoning, the Office Action cites MPEP §2173.05(p)(II), which states that, “a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite.”

Claim 70 is directed to a computer-readable storage medium, and therefore falls within the statutory category of a manufacture. Claim 70 does not recite an apparatus and method steps of using the apparatus. That is, while claim 70 recites a computer-readable medium, it does not recite method steps for using the computer-readable medium. Thus, MPEP §2173.05(p)(II) is not applicable to claim 70.

Rather, claim 70 recites a computer-readable storage medium encoded with instructions that, when executed, perform a particular method. Thus, claim 70 is directed to a computer-readable medium encoded with a specific type of instructions. The method recited in claim 70 describes the characteristics of the instructions.

Thus, claim 70 is not directed to multiple statutory categories, and it is respectfully requested that the rejection of claim 70 under 35 U.S.C. §112 be withdrawn.

#### *Claims 75-78*

The Office Action rejects claims 75-78 under 35 U.S.C. §112, second paragraph asserting that claim 75 covers more than one statutory class. Applicant respectfully traverses this rejection.

The Office Action contends that claim 75 is directed to more than one statutory class because it recites the terms “a storage system,” “a storage device,” and “a storage medium,” and steps of “receives a request” and “determines.” In support of this reasoning, the Office Action cites MPEP §2173.05(p)(II), which states that, “a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite.”

Claim 75 is directed to a storage system, and therefore falls within the statutory category of a machine. Thus, claim 75 is not directed to only a single statutory category. Moreover, even if claim 75 is somehow considered to fall into more than one statutory category (which it clearly does not), there is no prohibition on a claim crossing more than one category. The MPEP section cited by the Examiner does not state that a claim cannot fall into more than one category. It simply states a claim which claims both an apparatus and the method steps of using the apparatus is indefinite.

This section is not applicable to claim 75, as claim 75 recites a storage system, but does not recite method steps of using the storage system. Thus, claim 75 satisfies the requirements of 35 U.S.C. §112, second paragraph, at it is respectfully requested that the rejections of claim 75-79 be withdrawn.

### **Rejections Under 35 U.S.C. §101**

#### *Claims 70-74*

The Office Action rejects claims 70-74, which are directed to at least one computer-readable medium, asserting that these claims are not directed to a statutory category because the term “computer-readable medium” is broad enough to read on disembodied signals. Applicant has amended each of these claims to recite, “at least one computer readable storage medium.” As such, Applicant believes each of these claims is clearly directed to a tangible medium and satisfies the requirements of 35 U.S.C. §101.

#### *Claims 75-78*

The Office Action rejects claims 75-78 under 35 U.S.C. §101 asserting that claim 75, “recites method or instruction steps without a functional element within an operable computer such as a processor.” Applicant respectfully traverses this rejection.

Claim 75 does not recite method or instruction steps. Rather, claim 75 is directed to a storage system having physical hardware components, including “at least one storage device comprising at least one physical storage medium,” and “at least one controller.”

The Office Action appears to cite MPEP §2106.01 and §2106.02 in support of this rejection. These sections relate to descriptive material and mathematical algorithms respectively. Claim 75 is not directed to descriptive material or a mathematical algorithm. Rather, claim 75 is directed to an apparatus having hardware components, and is therefore statutory.

Accordingly, it is respectfully requested that the rejection of claims 75-79 under 35 U.S.C. §101 be withdrawn.

### **Rejections Under 35 U.S.C. §103**

The Office Action rejects claims 65-78 under 35 U.S.C. §103(a) as purportedly being obvious over Stuart (2005/0055519) in view of Cossey (2005/0070622). Applicants respectfully traverse this rejection.

Each of independent claims 65, 70, and 75 relates, in one way or another, to the retention period for a unit of content being stored in the content of the unit of content and the request to delete the unit of content identifying the unit of content using a content address generated, at least in part, from at least a portion of the unit of content.

The Office Action concedes that Stuart fails to disclose these limitations, but asserts that Cossey does. While Applicant agrees that Stuart does not disclose any of these limitation, Applicant respectfully disagrees with the assertion that Cossey does.

#### ***A. The Retention Period For A Content Unit Being Stored In The Content Of The Content Unit***

Cossey fails to disclose the limitation of each of claims 65, 70, and 75 that relates to the retention period for a unit of content being stored in the content of the unit of content.

Cossey discloses a technique by which information may be copied from one application program and automatically prepared, formatted, and pasted into another application program, without the user have to exit the current application program, open the destination application program, paste the copied text, and reformat it (§§0020-0031; Figure 1).

Figure 2 of Cossey shows a graphical user interface 200 with a “paste where” menu item that, when selected, prompts a user to enter a target destination at which the selected text is to be pasted (§0033). That is, a user can select some text to be copied and open the “paste where” popup menu 215. Selection of the “paste where” menu item causes a popup 215 to be displayed in which a user may enter a target destination in box 225 or select a target destination from a list 220 of predefined target destinations (§§0037-0038; §0042; Figure 2). The target destination is a destination at which the selected text is to be pasted.

Figure 4 of Cossey shows a graphical user interface (GUI) 400 that is used to configure which items (and how many items) are displayed in the predefined target destination list in Figure 2 (§0049). One option that may be specified via Figure 4 is to keep the most frequently used

destinations in the predefined target destination list (§0051). In addition, GUI 400 includes a history retention section 425 that allows a user to specify a duration for retaining information used to populate the predefined target destination list.

The Office Action asserts that the text that the user selects is a content unit and the address of the memory location to which this content unit is copied when the user selects the “paste where” function is the content address for this content unit. *See* Office Action, page 11. The Office Action also asserts that the retention period for this content unit is the value that user inputs into the History Retention Text Box 425 (e.g., three days), shown in Figure 4. *See* Office Action, page 11.

As discussed above, each of claims 65, 70, and 75 requires that the retention period for the content unit be stored in the content of the content unit. As discussed above, the Office Action contends that the content unit is the user-selected text and the retention period is the value input into box 425 in Figure 4. Clearly, the value that is input into box 425 in Figure 4 is not stored in the user-selected text. Thus, in Cossey, the retention period for the content unit is **not** stored in the content of the content unit.

***B. The Request To Delete The Unit Of Content Identifying The Unit Of Content Using A Content Address Generated, At Least In Part, From At Least A Portion Of The Unit Of Content***

Cossey fails to disclose the limitation of each of claims 65, 70, and 75 that relates to the the request to delete the unit of content identifying the unit of content using a content address generated, at least in part, from at least a portion of the unit of content.

First, Cossey fails to disclose or suggest a request to delete a content unit. As discussed above, the Office Action asserts that content unit is the user-selected text. Notably, the Office Action does not identify anything as being a request to delete this user selected text.

Moreover, Cossey fails to disclose or suggest a content address that is generated, at least in part, from at least a portion of the unit of content. As discussed above, the Office Action contends that the user-selected text is a content unit and contends that the address in memory to which this text is copied when the user selects the “paste-where” function is a content address. However, the address in memory at which this so-called content unit is stored is not generated from the content of the content unit.

As should be clear from the discussion above, Cossey does not disclose or suggest a retention period for a unit of content being stored in the content of the unit of content or a request to delete the unit of content identifying the unit of content using a content address generated, at least in part, from at least a portion of the unit of content. Thus, each of independent claims 65, 70, and 75 patentably distinguishes over Stuart and Cossey, whether taken alone or in combination. Accordingly, it is respectfully requested that the rejection of these claims under 35 U.S.C. §103(a) be withdrawn.

Claims 66-69 depend from claim 65, claims 71-74 depend from claim 70, and claims 76-78 depend from claim 75. Each of these claims is patentable for at least the same reasons as its respective independent claim. Accordingly, it is respectfully requested that the rejection of these claims be withdrawn.

**CONCLUSION**

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Dated: November 4, 2008

Respectfully submitted,

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